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09/450,399	11/29/1999	ROLF BRUCK	E-40456	7581

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EXAMINER

TRAN, HIEN THI

ART UNIT	PAPER NUMBER
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1764

DATE MAILED: 06/10/2003

172

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/450,399

Applicant(s)

BRUCK ET AL.

Examiner

Hien Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 12-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-24 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 7, line 2 "short" is a relative term and therefore is vague and indefinite.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1-4, 6, 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garcea (4,086,063) in view of WO 94/18441 and EP 470,113.

With respect to claims 1, 9-11, Garcea discloses an assembly for cleaning exhaust gas comprising:

a catalyst carrier body 11 for installation in an exhaust pipe casing 17, 18; said carrier body 11 having a longitudinal axis, an interior with a plurality of flow paths and an outer surface; and

at least one substantially plate-shaped retaining element 25, 34 to be fastened in said casing 17, 18, said retaining element having an opening formed therein for receiving and securing said carrier body 11, said retaining element having a protrusion surrounding only part of the outer surface of the carrier body 11 (Figs. 2-3), said retaining element fastened directly on said carrier body 11, and said retaining element at least one holding said carrier body together in a dimensionally stable state and substantially supporting said catalyst carrier body 11 on its own.

The apparatus of Garcea is substantially the same as that of the instant claim, but whether the plate-shaped retaining element 25, 34 in Garcea may be a corrugated plate-shape retaining element instead of a flat plate-shaped one of the instant invention.

However, the language of the claim does not exclude a corrugated plate retaining element of Garcea. In any event, EP 470,113 discloses the conventionality of providing a flat plate-shaped retaining element extending in a plane including an angle with the longitudinal axis of the catalyst carrier body. Since the shape of the retaining element is not considered to confer patentability to the claim, it would have been an obvious matter of design choice to one having ordinary skill in the art to select an appropriate shape for the plate retaining element of Garcea, such as the flat plate shape as taught by EP 470,113, since such a modification would have involved a mere change in the shape of a component. A change in shape is generally recognized

as being within the level of ordinary skill in the art, absence showing any unexpected results. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

The modified apparatus of Garcea is substantially the same as that of the instant claim, but fails to disclose whether the catalyst carrier may be a metallic catalyst carrier body without jacket tube and having sheet metal layers forming channels.

However, WO 94/18441 (Fig. 2) discloses that the catalyst carrier is a metallic catalyst carrier body having sheet metal layers forming channels.

It would have been obvious to one having ordinary skill in the art to substitute the catalyst carrier body of WO 94/18441 for the catalyst carrier body of Garcea for the known and expected results of obtaining the same results by different means in the absence of unexpected results.

With respect to claim 2, Garcea discloses that the carrier body has first and second parts, the exhaust pipe casing has an inflow chamber and an outflow chamber, said retaining element 25, 34 is to be connected to the casing 17, 18, the chambers permit the exhaust gas to flow through said carrier body from said inflow chamber into said outflow chamber (Figs. 2-3).

With respect to claim 3, Garcea discloses a muffler casing comprising two half-shells 17, 18.

With respect to claim 4, the retaining element of Garcea has two sides and the catalyst carrier body 11 protrudes substantially to the same extent from both sides (Fig. 2).

With respect to claim 6, referred to the rim of the retaining element 25, 34 of Garcea.

6. Claims 5, 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garcea (4,086,063) in view of WO 94/18441 and EP 470,113 as applied to claims 1-4, 6, 9-11 above and further in view of Bailey et al (4,050,903).

Garcea further discloses provision of mounting a catalytic converter 11 inside a muffler casing having a retaining element 34 with sloped opening for obliquely configuring the body in said opening.

Bailey et al disclose the conventionality of placing a catalytic converter inside a muffler casing having a retaining element with an elliptical opening (Fig. 5).

It would have been an obvious matter of design choice to select an appropriate for the opening structure of the retaining element, such as elliptical structure as taught by Bailey et al in the modified apparatus of Garcea, since such a modification would have involved a mere change in the shape of a component, absence showing any unexpected result. A change in shape is generally recognized as being within the level of ordinary skill in the art, absence showing any unexpected results. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

#### ***Response to Arguments***

7. Applicant's arguments filed 4/7/03 have been fully considered but they are not persuasive.

Applicants argue that the reference of Garcea does not show a substantially plate-shaped retaining element extending in a plane including an angle with the longitudinal axis of the catalyst carrier body. Such contention is not persuasive since Garcea does disclose a plate-shaped retaining element 25, 34 extending in a plane including an angle with the longitudinal axis of the catalyst carrier body. The plate-shaped retaining element of Garcea may be a corrugated plate-

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shape retaining element instead of a flat plate-shaped one of the instant invention. However, the language of the claim does not exclude a corrugated plate retaining element. In any event, WO 90/13736 discloses the conventionality of providing a flat plate-shaped retaining element extending in a plane including an angle with the longitudinal axis of the catalyst carrier body. Since the shape of the retaining element is not considered to confer patentability to the claim, it would have been an obvious matter of design choice to one having ordinary skill in the art to select an appropriate shape for the plate retaining element of Garcea, such as the flat plate shape as taught by EP 470,113, since such a modification would have involved a mere change in the shape of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art, absence showing any unexpected results. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hien Tran whose telephone number is 308-4253. The examiner can normally be reached on Tuesday-Friday from 7:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 308-6824. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-0661.

HT  
June 9, 2003

*Hien Tran*  
**Hien Tran**  
**Primary Examiner**  
**Art Unit 1764**